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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,583	08/03/2000	Gad Liwerant	VIDS-0001-P02	9242

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STRATEGIC PATENTS P.C..
C/O PORTFOLIOIP
P.O. BOX 52050
MINNEAPOLIS, MN 55402

EXAMINER	
SALTARELLI, DOMINIC D	
ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
12/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/631,583	LIWERANT ET AL.	
	Examiner	Art Unit	
	Dominic D. Saltarelli	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/27/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 7, 2007 has been entered.

Response to Arguments

2. Applicant's arguments filed September 7, 2007 have been fully considered but they are not persuasive.

3. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of "Streaming Email" (XP-002150023, supplied by applicant).

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment from a sender at a computer system (the video portion of a video message which is the personal communication, paragraph 48);

(b) acquiring advertisements from advertisers at the computer system (third party, advertiser provided advertisements, paragraph 49);

(c) offering to the sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message

button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose directly in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format;

(ii) creating an identifier for the video segment;

(iii) associating the video segment and the advertisement; and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 2, Rothschild and "Streaming Email" disclose the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (via pull down menu 404, Rothschild, paragraph 51).

Regarding claim 3, Rothschild and "Streaming Email" disclose the method of claim 2, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 4-6, Rothschild and "Streaming Email" disclose the method of claims 1 and 2, and further disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (Rothschild, paragraph 52, where if the sender fails to select a particular advertisement, they may select that a randomly selected advertisement be shown).

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements from advertisers (paragraph 64); and

receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link to the network accessible location, generating an electronic communication containing the link and addressed to the electronic email address, and transmitting the electronic communication.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 37, Rothschild and "Streaming Email" disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 38, Rothschild and "Streaming Email" disclose the method of claim 36, but fail to disclose publishing the link to a Web page.

The examiner takes official notice that publishing links to videos in web pages is notoriously well known in the art.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild and "Streaming Email" to include publishing the link to a Web page.

Regarding claim 39, Rothschild and "Streaming Email" disclose the method of claim 36, further comprising receiving a mailing list including a plurality of email addresses and transmitting the electronic message to the plurality of email messages (Rothschild teaches sending a single message to multiple recipients at once, paragraph 53).

Regarding claim 40, Rothschild and "Streaming Email" disclose the method of claim 36, wherein the link includes a path ("Streaming Email"

teachings sending a pointer file which designates the location of the file for streaming, page 308).

7. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email" and Ellis et al. (6,774,926, of record).

Regarding claim 7, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) selecting, by the sender, an advertisement stored at the server computer system by an advertiser (paragraphs 51-52); and

(c) transmitting from the sender computer to the server computer system an indication of the selected advertisement (paragraph 53).

Rothschild fails to disclose fails to disclose uploading a video segment from a sender computer system to the server computer system, and in response to receiving said indication the server computer system automatically:

(i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Rothschild and Ellis fail to disclose in response to receiving said indication the server computer system automatically:

(i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313,

"Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 8, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Rothschild, paragraph 52).

Regarding claim 9, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 8, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 10 and 11, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 8, wherein said criterion includes leaving said

selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild, Ellis, and "Streaming Email" as applied to claim 10 above, and further in view of Eldering et al. (6,820,277, of record) [Eldering].

Regarding claim 12, Rothschild, Ellis, and "Streaming Email" disclose the method of claim 10, but fail to disclose said selection is based on a price paid by the advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, and "Streaming Email" to select an advertisement based on a price paid by the advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

Conclusion

9. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DS

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600